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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,241	09/23/2003	Steffen Nock	020144-000520US	3544
20350	7590	02/22/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			NAFF, DAVID M	
		ART UNIT		PAPER NUMBER
		1651		

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/669,241	NOCK ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 23 September 2003.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-85 are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

***Election/Restrictions***

A preliminary amendment of 9/23/03 amended the specification, and presented claims 1-85 as original claims.

Claims in the application are 1-85.

5        Restriction to one of the following inventions is required under 35 U.S.C. 121:

I.      Claims 1-35 and 60, drawn to a method of immobilizing a polypeptide involving contacting a polypeptide having an ester or thioester with an anchor containing a first 10 nucleophilic group at a 2 or 3 position relative to a second nucleophile group, classified in class 435, subclass 174.

II.     Claims 36-45, drawn to an array of immobilized polypeptides wherein the array contains first and second polypeptides, classified in class 435, subclass 177.

15     III.    Claims 46-49, drawn to an array of immobilized polypeptides attached to a surface having a plurality of surface regions wherein each surface region has attached a polypeptide and a polynucleotide that encodes the polypeptide, classified in class 435, subclass 320.1.

20     IV.    Claims 50-55, drawn to a method of screening a library of nucleic acids to obtain a nucleic acid that encodes a polypeptide, classified in class 435, subclass 6.

V.     Claims 56-59, drawn to a nucleic acid comprising an expression cassette, classified in class 536, subclass 22.1.

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VI. Claims 61-76, drawn to a method of immobilizing a polypeptide having an ester or thioester using an anchor containing an NH<sub>2</sub>-NH-R or aminoxy group, classified in class 435, subclass 181.

5 VII. Claims 77-85, drawn to a kit containing an anchor molecule for use in immobilizing a polypeptide, classified in class 435, subclass 283.1.

The inventions are distinct, each from the other because:

The methods of Groups I, IV and VI each require different steps

10 and/or materials such that each can be performed without performing another of the methods to provide a different end result, and each method can be performed without using arrays as required by Groups II and III, a nucleic acid as required by Group V, and a kit as required by Group VII. The arrays of Groups II and III can have a use other  
15 than for immobilizing a polypeptide as required by Groups I and VI, and for screening as required by Group IV. The array of Group II does not require the array of Group III or the converse since the array of Group II requires first and second polypeptides and the array of Group III requires a polynucleotide. The arrays of Groups II and III do not  
20 require a nucleic acid as required by Group V and a kit as required by Group VII. The nucleic acid of Group V can be used other than in an array as required by Groups II and III and without forming a kit as required by Group VII. The kit of VII does not have to be used with arrays as required by Groups II and III and a nucleic acid as required  
25 by Group V. Examining inventions I-VII together would be a serious

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burden due to differences in claims of the inventions that would require different searches and considerations in regard to prior art.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their 5 different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10       Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a 15 request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### **Conclusion**

Any inquiry concerning this communication or earlier 20 communications from the examiner should be directed to David M. Naff whose telephone number is 571-272-0920. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this 25 application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for 5 unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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David M. Naff  
Primary Examiner  
Art Unit 1651

DMN  
2/24/06